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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/532,263      | 03/22/2000  | Douglas James Hilton | 10296A              | 8294             |

7590 04/24/2003

Scully Scott Murphy & Presser  
400 Garden City Plaza  
Garden City, NY 11530

EXAMINER

MERTZ, PREMA MARIA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1646     | 16           |

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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| EXAMINER |              |
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|          |              |
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16

DATE MAILED:

## BEST AVAILABLE COPY

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

### ADVISORY ACTION

#### THE PERIOD FOR RESPONSE:

a)  is extended to run 10 months or continues to run \_\_\_\_\_ from the date of the final rejection  
b)  expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due in accordance with 37 CFR 1.192(a).

Applicant's response to the final rejection, filed 4/15/03 has been considered with the following effect, but it is not deemed to place the application in condition for allowance:

1.  The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:

- There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
- They raise new issues that would require further consideration and/or search. (See Note).
- They raise the issue of new matter. (See Note).
- They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Amended claims 1 and 12 are subject to the 35 USC 112 1<sup>st</sup> paragraph description rejection because the issue here is that there is a lack of written description of the nucleic acid encoding L-11 receptor variants claimed in claims 1 & 12. The claimed subject matter is not described in such a way to reasonably convey that applicants were in possession of the nucleic acid encoding L-11 receptor variants, when the application was filed.

2.  Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.

3.  Upon the filing of an appeal, the proposed amendment  will be entered  will not be entered and the status of the claims will be as follows:

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 1, 5, 8-9, 11-12

However:

Applicant's response has overcome the following rejection(s): \_\_\_\_\_

4.  The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection because See Note above  
Furthermore, the declaration by Douglas James Hilton pursuant to 37 CFR 1.132 is non-persuasive because it fails to demonstrate that the written description in the instant specification is commensurate in the scope of the claims to the subject matter recited.  
5.  The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.

The proposed drawing correction  has  has not been approved by the examiner.

Other

*Prema Mertz*  
PREMA MERTZ  
PRIMARY EXAMINER